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APPLICATION NO.	FILED DATE	INVENTOR NAME (PRINT)	ATTORNEY DOCKET NO.	
09/286,119	04/02/1999	ITALO GOFFI	ITALO-ET-AL-	4550
7590		02/25/2004		
COLLARD & ROE 1077 NORTHERN BOULEVARD ROSLYN, NY 11576				
EXAMINER				
LORENZO, JERRY A				
ART UNIT		PAPER NUMBER		
1734		32		

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

eb32

Office Action Summary

Application No.

09/286,119

Applicant(s)

GOFFI ET AL.

Examiner

Jerry A. Lorengo

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-55 and 58-60 is/are rejected.
- 7) ☒ Claim(s) 56,57 and 61 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

(1)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 53, 54, 55 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,893,964 to Claveau (hereinafter "Claveau '964") in view of U.S. Patent No. 5,308,426 to Claveau (hereinafter "Claveau '426").

Regarding applicant claims 53 and 60, Claveau '964 discloses a process and apparatus for treating an article (artefact) comprising the steps of (Figures 8-10; column 3, lines 27-64:

(1) Forming an envelope 4' (enclosing/forming means) from a transfer support 6 (which is adapted to receive an article 2 therein) by folding the transfer support 6 in such a manner that

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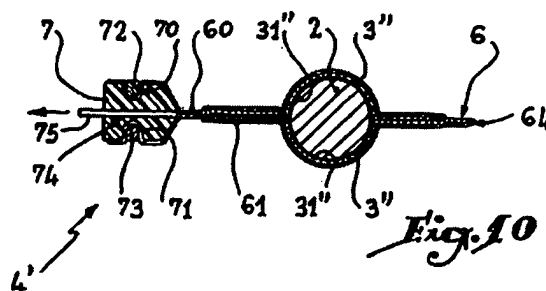
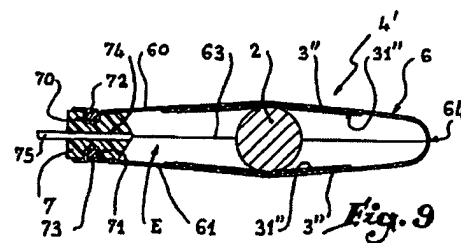
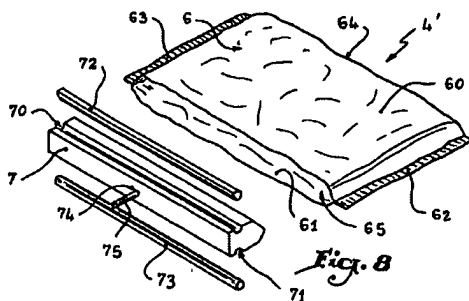
it forms two parallel sections 60, 61 with side edges perpendicular to the fold (which are sealed to form sealed edges 62, 63) and an open end 65 defined by the edge portions of the transfer support 6 parallel to the fold;

(2) Placing inkers 3'' carrying a transferable decoration (pattern) 31'' on their surfaces onto the two parallel sections 60, 61 of the transfer support 6;

(3) Placing the article 2 within the envelope 4' such that the inkers 3'' are disposed between the article 2 and the two parallel sections 60, 61 of the transfer support 6 forming envelope 4';

(4) Evacuating (sucking) air from the open end 65 of the envelope 4' with a sucking means, such as a vacuum pump, to cause the transfer support 6 and interposed inkers 3'' to come into intimate contact (adhere) to the sides of the article 2; and

(5) Transferring a pattern (decoration) 31'' from inkers 3'' onto the article 2 by heating both the envelope 4' and the article 2 therein with a heating means, such as a furnace, under the effects of pressure provided by the evacuation of the flexible envelope 4' (which also functions as the pressing means). The method of Claveau '964 is illustrated below:



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Although Claveau '964 discloses that pressure is applied to the decoration (pattern) 33" by the effect of the transfer support envelope 4" under evacuated conditions, they do not specifically disclose, as per applicant claim 1, that the pressure is applied to the pattern directly by the transfer support 6 from which the envelope 4' (enclosing and pressing means) is formed, i.e., the transferable pattern is carried directly upon the transfer support

Nonetheless, it would have been obvious to one of ordinary skill in the art at the time of invention to form the envelope 4' (enclosing and pressing means) of Claveau '964 with a transfer support having the transferable decoration (pattern) carried directly thereon without the use of the inkers 3" motivated by the fact that Claveau '426, also drawn to methods for the formation of transferable decorative patterns onto three-dimensional articles through the use of an evacuated envelope, discloses that the drawbacks of using such inkers 3" (such as failure to deform along its principal axes leading to creases and offsetting in the transferred decoration) can be avoided by utilizing a transfer support of extensible material having the decoration (pattern) carried directly on its surface such that the object, of any shape, to be decorated is enveloped in the extensible transfer support so that the ink-coated face of the transfer support is directly in contact with the surfaces of the object to be decorated (column 1, line 5 to column 2, line 25).

Regarding applicant claim 54, Claveau '964 discloses that the envelope 4" may be alternatively formed from a two transfer support sheets 8a,8b with the first 8a placed above the article 2 and the second sheet 8b placed below the article (Figures 12 and 13).

Regarding applicant claim 55, although neither Claveau '964 nor Claveau '426 specifically disclose that the transfer support is removed after handling and/or installation of the article, the skilled artisan would have appreciated the advantages of leaving the transfer film in place until utilization by the end use motivated by the fact that the transfer support would protect the decorated surface from marring by scuffs, scrapes and bumps during the time period between application, storage and final use. Furthermore, the skilled artisan would have appreciated the utility of leaving the transfer support in place until final use motivated by the fact that it is well known in the art that decorative bezels are commonly provided with a removable plastic protective film that remains over the bezel until removed by the end user.

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(2)

Claims 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as combined in section (1), above, in further view of U.S. Patent No. 6,136,126 to Fenzi.

Although the references as combined in section (1), above, disclose the overall method and apparatus of the instant invention, they do not specifically disclose, as per applicant claims 58 and 59, the times and temperatures utilized in the heating steps.

Nonetheless, the claimed times and temperatures would have been obvious to one of ordinary skill in the art at the time of invention motivated by the fact that Fenzi, also drawn to methods and apparatus of heat and vacuum transfer decorating by way of an enveloping means, discloses that the temperature and time parameters utilized during the heating step may be up to 280°C and from 30 seconds to 30 minutes, respectively (column 2, lines 57-51).

(3)

Allowable Subject Matter

Claims 56, 57 and 61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claveau '426, as combined in section (1), above, discloses that the transfer support comprises an extensible material, such as air-permeable fabric, on which is disposed the transferable decoration. Although WO 99/04982 to Claveau, also drawn to methods of heat and vacuum transfer decorating by way of an enveloping means, disclose that it is known to utilize a transfer support, having the transferable decorative pattern 12 carried thereon, consisting of a extensible, air-permeable transfer support 10, having a coating 11 of PVA disposed thereon, neither they nor any of the prior art of record specifically disclose that the transfer support is made from a gas-tight thermoformable material such as polyvinyl alcohol (PVA).

(4)

Response to Amendments and Arguments

The amendments and arguments filed with the request for Continued Examination on September 18, 2003 are acknowledged. In response to those amendments, claims 53-55 and 58-

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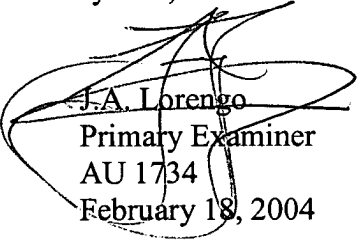
60 have been rejected on the grounds set forth in sections (1) to (3), above. In addition, new claim 61 and amended claims 56 and 57 have been objected to, as set forth in section (4), above. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

(5)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lorengo whose telephone number is (571) 272-1233. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino, can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J.A. Lorengo
Primary Examiner
AU 1734
February 18, 2004